

REMARKS

In the application claims 1-6 and 8-16 remain pending. Claim 7 has been canceled without prejudice. Claim 1 has been amended to include the elements of claim 7 and, as such, finds support in the specification and figures as originally filed. Claims 12-16 have been added by amended and also find support in the specification and figures as originally filed. No new matter has been added.

In the Office Action the disclosure was objected to as including informalities. In response, the specification has been amended in keeping with the suggestions set forth. Believing that the amendments to the specification cure the informalities noted, it is respectfully requested that the objection to the disclosure be withdrawn.

In the Office Action various of the claims were objected to as including informalities. In response, the claims have been amended in keeping with the suggestions set forth. Believing that the amendments to the claims cure the informalities noted, it is respectfully requested that the objection to the claims be withdrawn.

The pending claims stand rejected under 35 U.S.C. § 103 based primarily upon Scott ("You've Got Snail Mail") in view of Sparks (U.S. Patent No. 6,167,382) in further view of Rosser (U.S. Patent No. 6,446,261). The reconsideration of the rejection of the claims is, however, respectfully requested.

In response to the rejection of the pending claims, it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that a combination of references disclose the claimed subject matter "as a whole," i.e., each and every word. Furthermore, it is respectfully submitted that, when evaluating a claim under 35 U.S.C. § 103, it is impermissible to break the claim into its component parts and then merely find a reference containing one part, another reference containing another part, etc., while using the disclosure of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such "hindsight reasoning" is not used when assessing the patentability of a claimed invention,

a rejection based upon a combination of references requires a demonstration that an artisan of ordinary skill in the art at the time of the invention would have selected the various parts from the references and combined them in the claimed manner.

Turning now to the invention claimed, the invention claimed has, among others, the advantage of being operable with various franchises to, for example, prohibit one franchise operator from sending direct mail pieces for the purpose of soliciting the business of another franchise operator. To the end, the claimed method uses log-in information for a user to identify security rights for that user. The claimed method then uses the identified security rights to filter a list of recipients for a direct mail advertising campaign which list of recipients was compiled in keeping with the claim language. As will be understood, in this manner the claimed method may, for example, prevent one franchise operator from sending direct mail advertising to excluded addresses such as those addresses that are outside of a bounded delivery area.

In the Office Action it has been acknowledged that the combination of Scott, Sparks, and Rosser fails to disclose all of the steps now set forth in the claims. Specifically, in the Office Action it was acknowledged that Scott fails to disclose, teach, or suggest identifying the user's profile and security rights towards filtering the list of recipients for the direct mail advertisement. While the Office Action has taken "official notice" that it is well known to identify a user and establish his security rights, it is respectfully submitted that the mere fact this may be well known cannot be said to demonstrate the obviousness of further modifying Scott to arrive at the invention that is set forth in the claims "as a whole." More particularly, it is respectfully submitted that the allegedly known uses of security rights, such as to prevent unauthorized access to confidential information or to prevent printing of documents without mailing, simply cannot be said to teach or suggest modifying Scott to include the use of the security rights for the expressly claimed purpose of filtering a list of recipients compiled for a direct mail advertisement campaign.

In sum, it is respectfully submitted that the reliance upon the "official notice" that security rights are allegedly useful in preventing access to confidential information or receipt of a product without payment fails to demonstrate that an artisan of ordinary skill in the art at the time of the invention would have used "security rights" to modify Scott in the manner that is expressly claimed, i.e., to use security rights to filter a compiled list of recipients for direct mailing. Accordingly, it is respectfully submitted that the "official notice" is inadequate to support a *prima facie* case of obviousness and, as such, the rejection of the claims must be withdrawn. Furthermore, since it has been demonstrated that the "official notice" relied upon is inadequate to support a *prima facie* case of obviousness, it is respectfully submitted that the Examiner must provide documentary evidence in the next Office Action which can be said to support the espoused obviousness of modifying Scott if the rejection is to be maintained. (See MPEP § 2144.03).

At this time, it is additionally respectfully submitted that the art of record has been carefully reviewed and that no cited art can be said to disclose, teach, or suggest the elements set forth in newly presented, dependent claims 12-16. Accordingly, it is respectfully submitted that the subject matter of dependent claims 12-16 should be found to be patentable over the art of record.

CONCLUSION


It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

Should anything further be required, a telephone call to the undersigned, at (312) 456-8400, is respectfully invited.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Dated: March 22, 2006



Howard E. Silverman
One of Attorneys for Applicant

CERTIFICATE OF MAILING

I hereby certify that this EXTENSION OF TIME is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 22, 2006.



Howard E. Silverman